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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,002	11/09/2000	Minegishi Yukio	09564/002001	5998

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 07/29/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/711,002

Applicant(s)

YUKIO ET AL.

Examiner

Kurt Fernstrom

Art Unit

3712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 8-17.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Kurt Fernstrom
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Continuation of 2. NOTE: The amendments to claims 8 and 14 provide new limitations to the thought results, thus raising new issues. The issues for appeal are not reduced or simplified..

Continuation of 5. does NOT place the application in condition for allowance because: The apparatus which displays the thought result of the invention is not sufficient to provide a "practical application" to the invention. The claims remain rejected under 35 USC 101 under the rationale of *In re Abele*, 684 F.2d 902, 214 USPQ2d 682 (1982), which held that the step of displaying a calculation was not sufficient to overcome the rejections made under 35 USC 101. It should also be noted that *Abele* did not draw a distinction between the apparatus claim 7 reciting a display, and the method claim 5 which recited a method of displaying the data. Here, the claimed invention is not considered to be a product arrived at by grouping of thought results, but merely a display of the thought results themselves. The thought results are not incidental to the invention, but rather they essentially comprise the invention.

Also, the claimed invention is not considered to be within the technological arts, particularly with respect to claims 8-11, 13-16. The apparatus consists essentially of thought results being displayed on a medium. The provision of the medium itself, in these claims a piece of paper, is not sufficient to bring the invention within the scope of that which advances the technological arts, and thus would be patentable subject matter. See (Unpublished) *Ex Parte Bowman*, 61 USPQ2d 1669 (BdPatApp&Int 2001), which held that an abstract idea is not transformed into patentable technological art by recited steps of "transforming physical media into a chart" and "physically plotting a point on said chart." Although *Bowman* does not directly address the issue of displaying the results on a computer, as in claims 12 and 17 of the present invention, the inclusion of a computer is not considered to bring the subject matter into that which advances the technological arts. Although computer devices are generally considered to be within the technological arts, here the computer acts merely as a display medium for displaying thought results. The technology of the computer itself is not being used in a way that would provide any particular advantages over the display on a sheet of paper. Also, Applicant's characterization of claims 8 and 14 on page 8 of the remarks is contested. The claims do not recite storage or retrieval of data. The claims only recite that the thought results are displayed on a medium, and that the medium is a computer display. With respect to the two prong test of MPEP 2106 cited by applicant, here there is no physical transformation outside the computer, nor is there a practical application within the technological arts, for the reasons set forth above.

The argument presented concerning *Alappat* and *Diehr* are not persuasive because those holdings concerned inventions which were machines and machine processes. *Alappat* was directed to a means for creating a smooth waveform display in a digital oscilloscope. *Diehr* was directed to a process for molding raw, uncured synthetic rubber into cured precision products. In particular, *Diehr* based its holding in large part on the transformation of physical matter into a different state. The present invention is considered to be much more analogous to those of *Abele* and *Bowman*.